

## Remarks

### The amendment

Entry of the amendment is respectfully requested.

No new matter is added by the added claims, because each of the added claims is supported by the application as filed. Compound claim 53 corresponds to claim 1 as filed amended in accordance with the restriction requirement (limitation of both X and Y to O – which also eliminates Formula III and the definition of R<sup>7</sup> as unnecessary). The table below shows the correlation of the compound claims 53 - 76. Composition claims 78 and 79 correspond to claims 36 and 37 as filed, limited to the elected compounds, while method claims 80 - 94 correspond to claims 38-52 as filed, also limited to the elected compounds.

New claim	Old claim	Note
53	1	Limited to elected species (X = Y = O) – applies to all later claims
54		See page 28, line 19
55		See claim 28 and all exemplary compounds
56	2	
57	3	
58	7	
59	6	
60	10	
61		See page 23, lines 24-30
62		See all exemplary compounds
63		See elected exemplary compounds 1-65
64	12	
65		See all exemplary compounds
66	15	
67	16	
68	17	Written in dependent form
69	22	
70	23	
71	33	
72	24	
73	34	
74	25	
75	26	
76	31	
77	35	List limited to compounds where X = Y = O, Z = CH

### The restriction requirement

The Examiner had required election of a single value of X, Y, and Z, asserting "it is too burdensome for the examiner to examine more here". The Examiner further restricted out claims 38-50 and 52, "as they allege more than one use of the compounds"; and claims 37 and 51, having an additional active ingredient, "as an egregious burden".

Applicants respectfully submit that the assertion of burden on the examiner alone does not support a restriction requirement, and it is incumbent on the Examiner, if he wishes to make a restriction requirement, to show that the claimed inventions are capable of supporting separate patents and that they are independent or distinct (*sæ*, for example, MPEP 803 and MPEP 816). Further, in this application, all the claims (compound, composition, and method) prior to this amendment were properly dependent directly or indirectly on a single Markush claim, claim 1.

However, in the interest of expediting prosecution, Applicants have elected for examination the set of compounds where  $X = Y = O$ ; and all claims [other than claim 1, retained for completeness] are now limited to that set. Applicants further elect for examination the set of compounds where  $Z = C-R^8$  (but see below).

The Examiner had asked for a further limitation by election of Z. Applicants respectfully request that this requirement be withdrawn, as they believe that the election of X and Y made is of a sufficiently small class that the burden of examination has been substantially reduced. Claims to the species where Z is  $C-R^8$ , in particular,  $C-H$ , are present as claims 54 and 55.


The Examiner had further restricted out claims 37 and 51, as containing an additional species. Applicants respectfully request that this requirement be withdrawn as to new claims 79 and 93, because these claims, corresponding to prior claims 37 and 51 but limited in their compound scope, are each properly dependent on their immediately preceding claim. So, for example, composition claim 79 is properly dependent on composition claim 78 not containing the additional active ingredient, and will inherently be patentable if claim 78 is patentable. Thus there will be no additional burden on the examiner to examine these dependent claims.

The Examiner had further restricted out claims 38-50 and 52 as alleging more than one use of the compounds. Applicants respectfully request that this requirement be withdrawn because each of the claims is properly dependent directly or indirectly on compound claim 53. Thus, if the compounds are found patentable, their use will inherently be patentable, and there will therefore be no additional burden on the examiner to examine these dependent claims.

**Conclusion**

Entry of the amendment, and examination and allowance of the claims, are respectfully requested.

Respectfully submitted,

  
Sam L. Nguyen  
Attorney for Applicants  
Reg. No. 52,496

Heller Ehrman White & McAuliffe LLP  
275 Middlefield Road  
Menlo Park CA 94025-3506  
(650) 324-7028  
January 26, 2004